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<b>CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)</b>			Docket No. TPP 31333
Applicant(s): James A. SATCHELL, Jr. et al.			
Serial No. 09/686,626	Filing Date October 12, 2000	Examiner S. Garland	Group Art Unit 2121
Invention: VENDING MACHINE AND COMPUTER ASSEMBLY			
<p>I hereby certify that this <u>Request for Reconsideration; Supplemental Declaration of James A. Satchell, Jr. with best available copies of Exh. E, F &amp; G</u> (Identify type of correspondence)</p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>571-273-8300</u>)</p> <p>on <u>March 2, 2006</u> (Date)</p> <p><u>Thomas P. Pavelko</u> (Typed or Printed Name of Person Signing Certificate)</p> <p><u>[Signature]</u> (Signature)</p>			
Note: Each paper must have its own certificate of mailing.			

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of

Inventors: James A. SATCHELL, Jr. et al

Original U.S. Patent No.: 5,822,216, issued October 13, 1998

Reissue Application Serial No.: 09/686,626

Group Art Unit: 2121

Reissue Application Filing Date: October 12, 2000

Examiner: S. Garland

For: VENDING MACHINE AND COMPUTER ASSEMBLY

**REQUEST FOR RECONSIDERATION AND  
SUMMARY OF TELEPHONIC INTERVIEW**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicants express their gratitude to the courtesies extended to their undersigned representative by Examiner Garland in a telephone interview conducted January 12, 2006.

During the aforementioned interview, paragraphs 17 and 18 of the previous Office Action were discussed and the dates of various documents mentioned in these paragraphs 17 and 18 were questioned by the undersigned representative on behalf of the applicants. Applicants requested that copies of certain documents mentioned in paragraph 17 and 18 be supplied by the Examiner to establish various dates, but the examiner declined to supply such documents to applicants' undersigned representative.

Reconsideration of the previous rejections as set forth in the Office Action mailed December 2, 2005, is respectfully requested in view of the following comments.

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Applicants note that the Examiner has reopened prosecution and, therefore, applicants' previous submissions filed on March 31, 2005 and May 31, 2005, have been entered.

Reconsideration of the previous rejection of claims 114-127, 129 and 130 under 35 U.S.C. §251 as being an alleged improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based is respectfully requested.

Although the Examiner cites various precedents, each of these precedents require that the Examiner identify the subject matter surrendered in the application for patent, which is attempted to be recaptured. The applicants respectfully submit that the Examiner has not done so despite repeated requests from the applicants to specifically identify the manipulative steps being sought to be recaptured in the rejected claims 114-127, 129 and 130. The Examiner, having neglected and ignored the request to identify such manipulative steps that were surrendered, applicants respectfully submit that the rejection fails to find support in 35 U.S.C. §251 and, notwithstanding the authority cited by the Examiner, the rejection must fail.

Reconsideration of the previous rejection of the claims relying solely or in part on the Sokal et al reference, i.e., U.S. Patent 5,953,504, is respectfully requested.

For example, applicants have never claimed to invent vending machines. That is all that is shown by the Bradt et al teaching (U.S. Patent 4,839,505).

What applicants have claimed as their invention is to permit such conventional vending machines to become a portal for customers or the public to visit websites, e.g., by access to the internet.

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Applicants have presented evidence of conception of that invention prior to the Sokal et al reference. Applicants appreciate the Examiner's concession in paragraph 6 of the previous Office Action that in view of the various declarations of record, it shows that Mr. Satchell conceived the use of a vending machine as a doorway for the public to reach websites prior to the date of the Sokal et al reference.

Although the applicants note that the Examiner alleged in connection with conception that "the means themselves and their interaction must be comprehended also," applicants do not acquiesce that this is the proper standard and, furthermore, they have shown that, upon the disclosure of Mr. Satchell, corroborated by Ms. Dora Stroud and Mrs. Stachell, the "means themselves and their interaction" were also disclosed.

For example, applicants' initial concession that they are not the first to invent a vending machine, which is shown by Bradt et al, is clear evidence that the function of a vending machine, including the "means themselves and their interaction" were known.

Furthermore, it is undisputed that the internet itself is not the invention of Mr. Satchell, but the various components, including routers, servers, etc. that make up the internet were also known and the means to access to the internet was comprehended by those having ordinary skill in the art at the time the invention was made. However, using a vending machine to access the internet and visit websites was not known prior to the invention. However, mindful of the Examiner's statement in paragraph 7, that "no wiring diagrams nor wiring of the apparatus connecting these various elements has been disclosed," applicants remind the Examiner that they are neither claiming neither diagrams nor wiring of the apparatus. Rather, what they are claiming is a vending machine, and the

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use of a vending machine, the entire structure of which was admittedly known, in combination with the internet, the entire combination of the invention which can be accomplished by applying a computer and an access portal on the vending machine such that a patron of the vending machine or a member of the public could access the internet by the portal of the vending machine. In such a case, the patron or passerby, knowing that they wish to utilize the internet, could do so through the computer screen, joystick, selector buttons, etc. from reading the disclosure of applicants.

Applicants dispute the Examiner's mischaracterizations of declarant Satchell's statements in paragraphs 6 and 7 of his previous Declaration. What Mr. Satchell stated was prior to his invention, "the concept of a vending machine, such as a drink or soda machine, that would, via the internet and worldwide web, bring the vending machine into the entertainment world was unknown."

The Examiner cannot seriously be contending that Sokal's disclosure in October 1995, either invented the internet or invented vending machines. Rather, it was applicants who had conceived of their invention prior to Sokal, which was corroborated by others, e.g., Ms. Dora Stroud and, by having completed the conception of the invention of permitting patrons or passerbys of a vending machine the ability to access the internet via the portal of the vending machine, the "means" to accomplish the connection between that patron or passerby and the internet would have been readily understood to anyone of ordinary skill in the art to which this invention pertains.

With regard to the comments in paragraph 10 of the preceding Office Action, applicants submit the Supplemental Declaration of James A. Satchell, Jr. and, specifically, paragraphs 4-5, which shows that such documents were a continuation of work "on actually reducing to practice the invention" and not "primarily to marketing" as alleged by the Examiner. With regard to the

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Examiner's comments in paragraph 11 of the preceding Office Action, applicants direct the Examiner's attention to paragraphs 6-8 of the attached Supplemental Declaration of Mr. Satchell.

With regard to paragraph 12 and the allegedly unreadable/illegible of portions of Exhibits E, F (and Exhibit G of paragraph 13), applicants direct the Examiner's attention to paragraph 9 of the enclosed Supplemental Declaration and the attached best available copies of Exhibits E, F and G.

With regard to paragraph 15 and the "diligence," applicants again remind the Examiner that this is not a "contest" between two applicants claiming the same subject matter. It is clear that what applicants are claiming differs from the prior art. Accordingly, as there is "no contest" between two competing applicants for the same invention, the Examiner's reading of diligence is inconsistent with established practice. Note the Examiner's remarks regarding diligence "of the subject matter of the counts" (paragraph 15 of the last Office Action). A "count" is a term of art in an Interference, not in *ex parte* prosecution. Applicants have presented extensive evidence of reasonable diligence within the applicable time period of just prior to the filing of the Sokal et al reference on October 10, 1995, to the March 19, 1996, rejection and note that the Examiner has conceded that applicants were diligent from March 19, 1996 to the filing of the application U.S. Serial No. 08/715,232, which resulted in the patent undergoing reexamination. However, as to the specific time periods of November 12, 14 to 16 as allegedly not being accounted for, applicants respectfully disagree. Applicants have previously reminded the Examiner that Sunday was a worship day and November 12<sup>th</sup> was a Sunday. As to the dates of November 14 to 16, applicant respectfully directs the Examiner's attention to paragraph 10 of the Supplemental Declaration of Mr. Satchell.

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Applicants are cognizant of the Examiner's statements in paragraph 16 and the recitation of MPEP §§ 715-715.07(c), as well as 37 C.F.R. §1.131(b), but the Examiner has provided no application of those sections to the instant set of facts.

Initially, applicants note that the Examiner has the wrong date of the filing of the amendment in parent application Serial No. 08/429,583. Applicants again direct the Examiner's attention to the Declaration of Eric P. Robins, in which he attaches as Exhibits A-C, true and accurate reproductions of documents retrieved from the public pair portal and, specifically, to the fact that the specification, claims and drawings were filed not on December 26, 1995, but, rather, on November 8, 1995.

The applicants respectfully dispute the allegation that such documents were not filed until December 26, 1995, but offer that such documents may be the confirmation copy received through the mailroom of a duplicate, mail copy of the claims, specification and drawings submitted on November 8, 1995. Moreover, applicants respectfully submit that there was no new matter rejection in the parent application as to such subject matter and, moreover, such subject matter has been corroborated by the Declaration of Ms. Stroud in her Supplemental Declaration at paragraph 10. Accordingly, applicants respectfully submit that the Examiner is in error and that the evidence submitted by applicants clearly antedate the Sokal et al reference and establish a diligence from just prior to the date of the Sokal et al filing to the amendment of the application and thereafter until the filing of the application which matured into the patent undergoing reissue.

As to the remaining rejections of the claims, i.e., specifically, claim 130, as being anticipated or, in the alternative, obvious over Huegel (U.S. Patent 5,239,480); or anticipated by Kolls (U.S. Patent 5,637,845), the Examiner has admitted (Final Rejection, page 20, paragraph 27) that Huegel

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"does not specifically mention the term websites." The reference, lacking recited limitations of the claim, cannot possibly be anticipatory under 35 U.S.C. §102. Applicants already informed the Examiner that his position that "remote sites of Huegel are obviously, if not inherently, "websites" confuses the concepts of inherency and obviousness and provide evidence neither of anticipation nor obviousness. The authority on this issue is clear. Something that is inherent is not obvious. See, Kloster Speedsteel AB v. Crucible, Inc., 230 USPQ 81, 88 (Fed. Cir. 1986), stating "inherency and obviousness are distinct concepts." The inherency rejection must fail because not all "remote sites" are necessarily websites. Inherency requires inevitability. Furthermore, the obviousness rejection must also fail. The Examiner has not shown why one of ordinary skill in the art at the time of Huegel (filed February 1991), would find it "obvious" within the sense of 35 U.S.C. §103 to permit customers to access "websites" via the internet as claimed. There is no teaching, suggestion or motivation that would impel one skilled in the art to morph the network of Huegel which is merely a ticket dispensing device networked to a network of location processors equal to a location which an event is to be held to go beyond local processing and reach websites via the internet. See, also, Ex parte Levengood, 28 USPQ 2d, 1300, 1302 (BPAI 1993), wherein it was stated:

"That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion, unless said logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.

Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in any of the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual to combine the relevant teachings of the references." (citations omitted)



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Accordingly, an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. Accordingly, the §103(a) over Huegel must also fail.

Kolls does not permit customer access to websites as is required by the limitations of claim 130 against which it is applied under 35 U.S.C. §102(e). The Examiner's reliance on column 4, lines 27-34, as well as the additionally cited sections of Kolls, is misplaced. Therein it is suggested that "computer operated devices for online searching, database searching or printing may be used as a vending machine instead of a copy machine." Neither on-line searching or database searching inherently shows the use of the internet and "on-line service" is not necessarily a website nor is access via the internet required to access an on-line service." See, the contemporaneous publication of February 1996, printed in PCT Computer Online Super Guide, page 120, stating "the sudden popularity of the worldwide web has galvanized on-line services to expand the features and improve the reliability of the client software . . . in general, we found it a bit easier to move around online services through Navigator 2.0 on the web, but the web's content is far richer." Exhibit L to Declarations of Mr. Satchell and Asumudu (previously submitted). As the Examiner fails to find the cited limitations of the claims (an interactive consumer accessible internet communication system") in Kolls, Kolls cannot be a anticipatory reference under 35 U.S.C. §102(e). Despite applicants invitation to the Examiner to clearly point out the terms "internet" or "websites" in Kolls (penultimate paragraph of Request for Reconsideration After Final Rejection, filed March 31, 2005) the Examiner continues to fail to do so.

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In view of the foregoing, applicants respectfully submit that the Examiner has neither established any surrender of manipulative steps that would prohibit the broadened method claims from being reissued and that none of the rejections attempting to be applied has any merit.

For the foregoing reasons, withdrawal of all rejections and passage of the application to issue are respectfully requested.

If any fees are due, the undersigned authorizes such fees to be charged to Deposit Account No. 19-4375.

Respectfully submitted,



Thomas P. Pavelko  
Registration No. 31,689

TPP/mat  
Attorney Docket No.: TPP 31333

Attachments:

Certificate of Transmission via Facsimile  
Supplemental Declaration of James A. Satchell, Jr. with best available copies of Exhibits E, F & G previously submitted

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Date: March 2, 2006